REMARKS

Reconsideration of the application, as amended, is respectfully requested.

I. STATUS OF CLAIMS

Claims 1, 4-10, 12, 13, 16-19, 21, 24-31, 33-38, 40, 41 and 43-48 are pending in this application. Claims 11, 20, 23, 32 and 42 have been canceled without prejudice. Claims 1, 12, 13, 21, 33 and 43 have been amended to more particularly point out and distinctly claim that which applicants regard as their invention. New claims 44-48 have been added. It is respectfully submitted that no new matter has been added by virtue of this amendment. Support for the new claims and the amended claims are found throughout the specification as originally filed.

II. Double Patenting Rejections

A. Statutory Double Patenting Rejections

The Examiner has provisionally rejected Claim 12 rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 1 of copending Application No. 10/071545 ("the '545 application"). A 35 U.S.C. § 101 double patenting rejection is only available for the same invention. The test is whether a product or process could literally infringe the rejected claim and not the patented claim, or vice versa. *See In re Vogel, 164 U.S.P.Q. 619, 622 (C.C.P.A 1970).*

Claim 12 of the presently claimed invention, as amended does not claim the same invention as

claim 1 of the '545 application because one could literally infringe claim 1 of the '545 application without literally infringing claim 12 of the present claimed invention, as amended.

For the reasons set forth above, Applicants respectfully request that the Examiner's statutory double patenting rejection be withdrawn.

B. Obviousness Double Patenting

Claims 1-11 and 13-43 of the presently claimed invention were provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/071545. In addition, claims 1-43 were also provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/966680.

In response, terminal disclaimers in compliance with 37 C.F.R. § 1.321(c) have been submitted herewith with respect to U.S. Patent Application Serial No. 10/071545 and U.S. Patent Application Serial No. 09/966680.

III. 35 U.S.C. § 112, First Paragraph

Claims 11, 20, 32, and 42 were again rejected under 35 USC 112, first paragraph. In particular, the Examiner asserts that the terminology "data-reader writer writes data to the data

storage device" was not enabled or supported in the specification.

In response, Applicants reassert their previous position that the original claims form a basis of the disclosure and that one skilled in the art would readily understand the above terminology in claims 11, 20, 32 and 42, and thus these claims are adequately enabled. And supported in the specification of the present application as originally filed

Notwithstanding the above, in order to expedite the prosecution of the present application, claims 11, 20, 32 and 42 have been canceled herewith. Therefore, the above rejections are now moot.

IV. REJECTIONS UNDER 35 U.S.C. § 103(a)

A. Rejection of Claims 1, 5-11, 13, 17-20, 33, 40-43 under 35 U.S.C. 103 (a) over U.S. Patent No. 6,071,166 to Lebensfeld et al. in view of U.S. Patent No. 6,254,486 B1 to Mathieu et al

Claims 1, 5-11, 13, 17-20, 33, 40-43 were rejected under 35 U.S.C. 103 (a) over U.S. Patent No. 6,071,166 to Lebensfeld et al. ("the Lebensfeld patent") in view of U.S. Patent No. 6,254,486 B1 to Mathieu et al ("the Mathieu patent") The Examiner realleges all of his previous assertions with regards to the Lebensfeld and Mathieu patents for the above noted claims.

In response, Applicants respectfully assert that the Lebensfeld patent and the Mathieu patent alone or in combination do not teach nor suggest claims 1, 13, 33 and 43, as amended.

As conceded by the Examiner in the present Office Action, the Lebensfeld patent fails to teach

an amusement device having a motor associated with a body and coupled to a transport element, a wireless receiver operably coupled to a microprocessor, a unit wireless transmitter associated with a body and coupled with a microprocessor, a remote wireless transmitter operatively coupled with a wireless receiver, and a least two wheels.

The Examiner attempts to cure the above deficiencies of the Lebensfeld patent, by combining the Mathieu patent with the Lebensfeld patent. Specifically, the Examiner takes the position that Mathieu patent discloses "...an interactive amusement device like that of Lebensfeld..." and that it would have been obvious in view of the Mathieu patent to produce the device of Lebensfeld with the missing elements set forth above for the purpose of providing a remote controlled moving device that can simulate a battle scenario.

However, it is respectfully submitted that there is no motivation provided to one skilled in the art to combine the Lebensfeld and Mathieu patents. Further, even if there were motivation to combine these references, this combination would fail to teach or suggest all of the elements of claims 1, 13, 33 and 43, as amended.

First, with regard to the lack of motivation point, one skilled in the art would not be motivated to make the above combination. Obviousness can only be established by combining or modifying the teachings of the prior art in an attempt to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See M.P.E.P. § 2143.01.*

Applicants disagree with the Examiner's assertion in the current Office Action that "Mathieu discloses "an amusement device like that of Lebensfeld". Rather, the Lebensfeld patent and the Mathieu patent are very distinct operationally from one another, and thus one skilled in the art would not be motivated to make this combination. Specifically, Lebensfeld relates essentially to a toy object, e.g. a robot, which is provided with an accessory, e.g. a backpack which includes an energy emitter and energy detector. The toy object is manually movable by a human player during use. In contrast, the device in Mathieu relates essentially to a pair of remote control gaming components, e.g. toy robots which are controlled via a remote control and movable via two electric motors operately connected to the legs of the device. As can be gleaned from above, in order for the device in Lebensfeld to move, it most be physically moved or lifted (e.g. with hands) by the user, whereas the device in Mathieu is moved via electrically powered motors within the device. Due to these significant differences in operation between the two references, one skilled in the art would not be motivated to make this proposed combination.

Further, one skilled in the art would not be motivated to make the above combination because there is no benefit in doing so. In particular, the Lebensefeld patent does not contain any additional elements than the Mathieu patent which would enable one skilled in the art to arrive at the presently claimed invention. The Examiner appears to cite Lebensfled for the "ciruit board" which controls the infra-red energy emitting and detection of the device, including activitating a hit light or speaker when detecting infra-red energy from a second device. However, the Mathieu similarly has an infrared energy detector and emitting assembly. In sum, modifying the Lebensfeld patent does not bring one

skilled in the art any closer to arriving at the presently claimed invention then the just using the Mathieu patent alone. Accordingly, there would be no motivation to one skilled in the art to make this combination.

Consequently, even if there were motivation to make the above proposed combined, this combination would still fail to teach each and every element of the presently claimed invention. Namely, at the very least this combination fails to teach or suggest a data storage device separate from said amusement device as recited in independent claims 1, 13 and 33, as amended or a data card separate from said amusement device, as recited in independent claim 43, as amended. Moreover, at the very least this combination also fails at the very least to teach of suggest a data storage device (as recited in claim 1, 13 and 33, as amended) or data card (as recited in claim 43, as amended) which provides a data an enhanced function to the amusement device, whereby said enhanced function must at least include one of the following enhanced functions selected from the group consisting of: increased mobility, increased speed, enhanced defense and diminished defense.

For the reasons set forth herein above, withdrawal of the rejection of claims 1, 13, 33 and 43. As claims 5-10 depend from and incorporate the limitations of independent claim 1 and claims 17-19 depend from and incorporate the limitations of independent claim 13, withdrawal of the rejection of these claims are also requested.

B. Rejection of Claims 4, 12, 16 and 34-38 under 35 U.S.C. 103 (a) over the Lebensfeld patent and the Mathieu patent in view of U.S. Patent No. 5,768,223 to Li et al.

Claims 4, 12, 16 and 34-38 were rejected under 35 U.S.C. 103 (a) over the Lebensfeld patent and the Mathieu patent in view of U.S. Patent No. 5,768,223 to Li et al ("the Li patent").

With regard to claims 4, 12, 16, 34-38, the Examiner realleges all of his previous assertions with regards to the Lebensfeld, Mathieu and Li patents.

In response, for the reason stated above, there is no motivation provided to one skilled in the art to combine the Mathieu patent with the Lebensfeld patent. Accordingly, the Examiners proposed combination of Lebensfeld, Mathieu and Li also fails.

Even assuming arguendo that there were motivation to make the above combination suggested by the Examiner, the Li reference would still not cure the deficiencies of the Lebensfeld and Mathieu patents. Namely, the Li patent is directed to an audio device having an audio unit containing a slot for receiving a plurality of audio cards to produce audible sounds. Thus, if the audio card/audio unit described in the Li patent were added to the Lebensfeld/Mathieu device, a toy, e.g. robot with audio capabilities would result. However, the above combination would still at

the very least the least fail to teach or suggest a data storage device which enhances a function of the amusement device, whereby said enhanced function must at least include one of the following enhanced functions selected from the group consisting of: increased mobility, increased speed, expanded defense and diminished defense , as recited in claims 4, 12, 16 and 34-38.

Further, applicants disagree with the Examiner's contention that the Li patent discloses an interactive amusement device, which teaches the use of a data card and data card reader to upgrade certain functions of a device such as mobility and speed. First of all, the Li patent has virtually nothing to do with mobile toy devices, but rather the Li patent is primarily concerned with providing an audio device which is easy to operate and has a relatively simple structure and is inexpensive to manufacture. Although the Li patent does briefly mention providing movement to a toy via its audio card, the Li patent is completely silent with regard to enhancing these movements or enhancing the speed and/or defense of a toy device using its audio card, as recited in claims 4, 12, 16 and 34-38.

Thus, for all of the reasons mentioned above, the Lebensfeld, Mathieu and Li patent combination fails to teach or suggest of the amusement device as recited in claims 4, 12, 16 and 34-38, of the presently claimed invention. Withdrawal of the rejections to claims 4, 12, 16, 34-38 is thus respectfully requested.

C. **Rejection of Claims 21, 23, 26, 30-32 under 35 U.S.C. 103 (a) ver the Lebensfeld patent and the Mathieu patent in view of U.S. Patent No. 5, 100,138 to Wilde, U.S. Patent No. 3,659,379 to Suda, or U.S. Patent No. 3,199,249 to Carver et al.**

Claims 21, 23, 26 and 30-32 were rejected under 35 U.S.C. 103 (a) over the Lebensfeld et patent and the Mathieu patent in view of U.S. Patent No. 5, 100,138 to Wilde ("the Wilde patent"), U.S. Patent No. 3,659,379 to Suda ("the Suda patent"), or U.S. Patent No. 3,199,249 to Carver et al ("the Carver patent").

With regard to claims 21, 23, 26, and 30-32, the Examiner realleges all of his previous assertions with regards to the Lebensfeld, Mathieu, Wilde, Suda and Carver patents.

In response, for the reason stated above, there is no motivation provided to one skilled in the art to combine the Mathieu patent with the Lebensfeld patent. Accordingly, the Examiners proposed combination of Lebensfeld, Mathieu and Wilde, Suda and Carver patents also fails.

Even assuming arguendo that there were motivation to make the above combination suggested by the Examiner, the Wilde, Suda and/or Carver patents would still not cure the deficiencies of the Lebensfeld and Mathieu patents. In particular, the Examiner states that the Wilde, Suda and Carver patents "...disclose a remote control interactive toy which teach a motor coupled to at least two arms..."

Nevertheless, the Wilde, Suda and Carver patents each fail to teach or suggest a data storage device which is separate from said amusement device and which enhances a function of the amusement device, whereby said enhanced function must at least include one of the following enhanced functions selected from the group consisting of increased mobility, increased speed, expanded defense and diminished defense of the amusement device as recited in independent claim 21. The Wilde, Suda and Carver patents therefore fail to cure the deficiencies of the Mathieu patent and the Lebensfeld patent.

Withdrawal of the rejection of independent claim 21 is respectfully requested. As claims 26, 30 and 31 depend from and incorporate the limitations of independent claim 21, withdrawal of the rejection of these claims are also requested.

D. Rejection of Claims 24-25, 27-29 under 35 U.S.C. 103 (a) over the Lebensfeld patent and Mathieu patent , the Wilde patent, the Suda patent, or the Carver patent in view of Li et al.

Claims 24-25 and 27-29 were rejected under 35 U.S.C. 103 (a) over the Lebensfeld patent and the Mathieu patent, the Wilde patent, the Suda patent, or the Carver patent in view of U.S. Patent the Li patent.

With regard to claims 24-25 and 27-29, the Examiner realleges all of his previous assertions with regards to the Lebensfeld, Mathieu, Wilde, Suda, Carver and Li patents.

In response, for the reason stated above, there is no motivation provided to one skilled in the art to combine the Lebensfeld, Mathieu,Wilde, Suda, Carver patents with one another. Accordingly, the Examiners proposed combination of the Li patent with the above patents also fails.

For the sake of argument, even assuming that there were motivation to make the above combination suggested by the Examiner, the Li patent would still not cure the deficiencies of the Lebensfeld and Mathieu patents because, as previously discussed herein, the Li patent fails at the very least to least to teach or suggest a data storage device which enhances a function of the amusement device, whereby said enhanced function must at least include one of the following enhanced functions selected from the group consisting of: increased mobility, increased speed, expanded defense and diminished defense , as recited in claims 24-25 and 27-29.

Withdrawal of the rejection of claims 24-25 and 27-29 is respectfully requested.

Finally, new claims 44-48 are patentable over the Lebensfeld, Mathieu, Li, Wilde, Suda, Carver patents, either alone or in combination with one another for the same reasons as set forth above. In addition, new claims 44-48 are further distinguishable over the above cited patents because these patents also fail to teach or suggest an amusement device which further comprises (I) a card game, wherein the card game is played using a number of said data storage cards or (ii) wherein the amusement device receives information or commands from said data storage cards to

perform actions which complement the card game.

Therefore, new claims 44-48 should be deemed allowable.

V. CONCLUSION

In view of the actions taken and arguments made it is believed that all pending claims as currently presented are now in condition for allowance. A Notice of Allowance is respectfully requested.

According to currently recommended Patent Office policy, the Examiner is requested to contact the undersigned at the telephone number provided below in the event that a telephone interview will advance the prosecution of this application. An early and favorable action is earnestly solicited.

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Respectfully submitted,

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